

Appl. No. 10/696,148
Resp. dated April 18, 2006

Reply to Office Action of Jan. 13, 2006

REMARKS

The January 13, 2006 Action rejected all claims pending in the application. This Response amends claims 1 and 14, requests the Examiner to reconsider the rejections and issue a timely notice of allowance.

Claim Rejections –35 USC§102(e)

All claims, 1-18, stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Application Pub. No. 2004/0196963 to Appelman et al. The Appelman Patent Application was filed on December 30, 2003 and claims priority under 35 U.S.C. §119(e) to Appelman Provisional Application No. 60/459,273 filed on April 2, 2003. On June 10, 2004, a preliminary amendment was filed to amend the Appelman Patent Application to claim priority to Murphy Provisional Application No. 60/474,207 filed on May 30, 2003.

Applicant's application under examination was filed on October 29, 2003, prior to the Appelman Patent Application filing date but after the Appelman and Murphy Provisional filing dates.

Applicant has carefully reviewed the specifications of the Appelman Patent Application, the earlier filed Appelman Provisional Application, and the earlier filed Murphy Provisional Application. In Applicant's October 27, 2005 response, Applicant submits that additional subject matter was included in the Appelman Patent Application that is not supported by the earlier filing date of the Appelman Provisional. For example, the Appelman Provisional Application fails to disclose receiving ***a call-control option simultaneous with the message alert*** as recited in Applicant's claims. In the January 13, 2006 Action, the Examiner disagreed by stating that the Appelman Provisional discloses "*using an audible sound (call control option) for various messaging events such as the receipt of an instant message (message alert).*" For the reasons stated herein, Applicant submits that the Appelman Provisional fails to support each and every element of Applicant's claims. Moreover, the Appelman Patent Application fails to teach each and every element of Applicant's claims and includes new subject matter *not disclosed* in the Appelman Provisional or the Murphy Provisional. Because Applicant's filing date predates the Appelman Patent Application,

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any new subject matter added by Appelman in the Patent Application cannot be used to anticipate Applicant's claims.

Appelman Provisional Application – “Concatenated Ring Tones”

Briefly, the Appelman Provisional Application discloses defined sounds concatenated with ring tones to assist the call recipient in identifying the caller. For example, the tail end of the ring tone is customized to include the defined sound and, by playing the sound, serves to identify the caller. Thus, by listening to the particularized audible sounds, the call recipient is able to identify who is calling before answering the call. The concatenated ring tones may be used in an instant messaging context to provide concatenated sounds for various instant messaging events, such as the receipt of an instant message from a sender. For example, the typical door opening/door closing sound that is played to a user (e.g., potential recipient) when a sender signs on or off may also be concatenated with a sound indicating precisely which buddy (e.g., potential sender) is signing on or signing off. So again, the concatenated ring tones, as disclosed, aid the recipient in audibly identifying who is sending an instant message.

As disclosed in the Appelman Provisional, the user is required to listen to the distinctive sounds and ring tones to identify the calling party. The Appelman Provisional fails to teach, suggest, or disclose viewing a call-control option as recited in Applicant's claims.

Murphy Provisional Application – “Spoken User Identifier”

Briefly, the Murphy Provisional Application discloses capturing the spoken version of a user identifier in an audio file, storing the audio file in a central data store, and enabling computer system users to access and render the stored audio file when perception of the user identifier is enabled in a user interface. For example, the stored audio file is played to inform the caller of the user identifier used to reach the call recipient.

As disclosed in the Murphy Provisional, the user is required to listen to the audio file for identification purposes. The Murphy Provisional fails to teach, suggest, or disclose viewing a call-control option as recited in Applicant's claims.

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For disclosure purposes, Applicant includes the Murphy Provisional Application on the accompanying IDS and requests the Examiner sign and return a copy of same to Applicant.

Appelman Patent Application – “Concatenated Audio Messages”

Briefly, the Appelman Patent Application discloses audibly identifying an event by playing, in response to a notification, at least portions of first and second sounds related to the event. (Appelman Abstract; paragraph 9)

The Examiner cited Appelman Figure 3b for disclosing the following element of Applicant's claims: “viewing the alert comprising an information message and a call-control option.” Figure 3b is a pop-up window providing the user the option to authorize or reject the audio identifier. (See also paragraph 66). Applicant disagrees with the Examiner that Figure 3b and the accompanying text disclose the cited elements of Applicant's claims. Nonetheless, the Appelman Patent Application does introduce the option of viewing a pop-up window and selecting whether or not to hear the associated audio identifier. As previously pointed out, the Appelman and Murphy Provisional Applications disclose “listening” to audible sounds for identification purposes and are silent with respect to “viewing” anything. Hence, any reference to subject matter not previously disclosed in the Provisional Applications must be considered new matter and cannot receive the benefit of either Provisional earlier filing dates. Applicant respectfully submits that the Examiner's reference to Appelman subject matter that is not supported by either Provisional Application is without merit and cannot be used to reject Applicant's earlier filed patent application.

Applicant respectfully requests that the Examiner reconsider the cited reference and withdraw the §102 rejections to claims 1-18.

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CONCLUSION

Applicant respectfully requests withdrawal of the § 102 rejections and issuance of a timely Notice of Allowance. Should the Examiner wish to discuss any of the above in greater detail then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Respectfully submitted,
Inter-Tel, Inc.

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